

REMARKS

Claim Rejections

Claims 1-3 --- 35 U.S.C. § 103(a)

Claims 1-3 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Pat. Pub. No. 2003/0076758 to Nakamura *et al.* ("Nakamura") in view of U.S. Pat. Pub. No. 2002/0041553 to Saga *et al.* ("Saga"). Applicant traverses this rejection.

Addressing claim 1, the combination of Nakamura and Saga does not disclose or suggest at least wherein said plurality of prepit forming regions are disposed apart from one another by a distance which is 300 or more times a recording channel bit length along said recording track, and each of said prepit forming regions having a fixed length which is 36 or less times said recording channel bit length along said groove or land, as recited in the claim. The Examiner concedes that Nakamura fails to disclose or suggest at least the above-noted features, but alleges that it would have been obvious based on the disclosure of Saga to provide these features.

Applicant respectfully disagrees.

Saga merely discloses *dimensions between prepits constituting a pattern* formed in an identification information portion of the optical recording medium track. See paragraph [0051]. In other words, Saga discloses a prepit pattern in a prepit area of a land or groove and defines the spacing and length of the prepits. Further, Saga discloses a channel bit length which is a function of a clock signal and a motion speed of a laser spot (paragraph [0037]). The Examiner alleges that it would have been obvious to modify the space between the prepits to a desired length. Applicant respectfully submits that the Examiner misapplies the reference to the claim.

Embodiments of Applicant's invention provide for a prepit region to be equal to or less than 36 recording channel bit lengths and for an interval of 300 or more recording channel bit

lengths between prepit regions to prevent servo characteristics from degrading into ensure the accuracy of the positional control of the focusing beam. Saga merely discloses dimensions of prepits in a prepit area. However, neither Saga nor Nakamura, individually or in combination, disclose or suggest the above-noted claimed features.

Further, even though Saga and Nakamura do not disclose or suggest all of the claimed features, the Examiner alleges that the motivation for combining the teachings of Saga and Nakamura is simply that a channel bit length and a detection window width are taught by the references. Applicant submits that the motivation supplied by the Examiner is insufficient. Neither reference, absent impermissible hindsight based on Applicant's disclosure, provides the requisite motivation to combine the references to result in the features claimed by Applicant. And, even if one of ordinary skill in the art at the time the invention was made had been motivated to combine the references, the combined references would still not disclose all of the claimed features.

Further, the combination of Nakamura and Saga does not disclose or suggest at least wherein said prepit forming regions have a fixed length which is 3 or less tracks long along said radial direction, as recited in the claim. As disclosed in paragraphs [0050] and [0089] of Nakamura, Figs. 1 and 6 show *part of the tracks* disposed in a spiral or as concentric circles. Therefore, the number of tracks corresponding to the prepit forming region is not specifically recited and thus is not limited to 3 or less, as required by the claim.

Also, paragraph [0051] of Nakamura discloses that the track includes a plurality of address blocks 108, each of which include a single land sector portion 109 and a single groove sector portion 110. Figure 6 of Nakamura shows a single land sector portion 109 and 2 groove sector portions 110 in an address block 108. However, given the above description, it is clear

that a land sector portion 109 disposed outside the illustrated groove sector portions 110 is merely omitted to more easily depict the illustrated features.

Accordingly, claim 1 is patentable over the combination of Nakamura and Saga. Claims 2 and 3 are patentable at least by virtue of their dependence.

Claims 4-9 -- 35 U.S.C. § 103(a)

Claims 4-9 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nakamura in view of Saga, and further in view of U.S. Pat. No. 6,256,282 to Yamagami *et al.* ("Yamagami") and U.S. Pat. Pub. No. 2003/0053403 to Miyamoto *et al.* ("Miyamoto").

Applicant traverses this rejection.

The combination of Nakamura, Saga, Yamagami and Miyamoto does not disclose or suggest at least the above-noted features of claim 1 which are incorporated into claims 4-9 by virtue of their dependence from claim 1. As established above, the combination of Nakamura and Saga fails to disclose or suggest these features. Yamagami and Miyamoto, either alone or in combination, do not disclose or suggest the features missing in the Nakamura-Saga combination.

Yamagami is directed to optimizing the amplitude of track wobbling, while Miyamoto discloses shifting of information recording unit regions as well as identification or address data of adjacent plural tracks on a recording medium. However, neither Yamagami nor Miyamoto, alone or in combination, disclose or suggest the above-noted features deficient in the combination of Nakamura and Saga.

Since the combination of Nakamura, Saga, Yamagami and Miyamoto does not disclose or suggest all of the features claimed by Applicant, one of ordinary skill in the art at the time the invention was made would not have been motivated to combine the references as attempted by the Examiner.

Accordingly, claims 4-9 are patentable over the combination of Nakamura, Saga, Yamagami and Miyamoto.

Claims 10-17 --- 35 U.S.C. § 103(a)

Claims 10-17 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nakamura in view of Saga, Yamagami and Miyamoto, and further in view of U.S. Pat. Pub. No. 2002/0136134 to Ito *et al.* ("Ito"). Applicant traverses this rejection.

The combination of Nakamura, Saga, Yamagami, Miyamoto and Ito does not disclose or suggest at least the above-noted features incorporated into the claims by virtue of their dependence from claim 1. As established above, the combination of Nakamura, Saga, Yamagami and Miyamoto does not disclose or suggest these features. Ito does not provide the disclosure missing and the combination. The Examiner has cited Ito only against claim 10.

The Examiner relies on Ito only to allegedly disclose a wobble cycle in relation to a frame cycle. However, even if Ito provides such disclosure, Ito fails to disclose or suggest the above-noted features missing in the combination of Nakamura, Saga, Yamagami and Miyamoto.

Therefore, one of ordinary skill in the art at the time the invention was made would not have been motivated to combine the references as attempted by the Examiner, since the attempted combination does not disclose or suggest all of the claimed features.

Accordingly, claims 10-17 are patentable over the combination of Nakamura, Saga, Yamagami, Miyamoto and Ito.

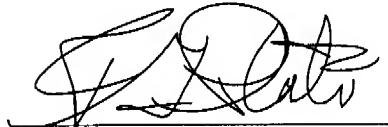
Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Francis G. Plati, Sr.
Registration No. 59,153

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: December 15, 2008